

REMARKS/ARGUMENTS

Rejection under 35 U.S.C. § 103(a)

Claims 1-4, 6-8, 11, and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hopkinson et al (US 2003/0050194) (“Hopkinson”) and Schlatter et al (US 2005/0215432)(“ Schlatter”).

Applicants respectfully traverse. Applicants submit that Examiner has failed to establish a *prima facie* case of obvious.

Applicants note that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP 2141.02(I); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

Applicants respectfully submit that while the Examiner has cited Hopkinson for disclosing certain pesticidal compounds and surfactant systems and Schlatter for teaching insecticidal compositions can optionally contain non-ionic surfactants such as ethoxylated tristyrylphenol and ethoxylated nonylphenol, however the Examiner has failed to provide any rationale as to why a person of ordinary skill in the art would combine Hopkinson and Schlatter to arrive at the present claims. Applicants submit that Examiner has provided only a conclusory statement in lieu of rationale, which states “one would have been motivated to do this since Hopkinson allows for the inclusion of a nonionic surfactant and since both Schlatter et al. and Hopkinson et al. teach the utility of controlling insects.” Applicants respectfully submit that such proposed rationale by the Examiner is in error as “teach[ing] the utility of controlling insects” is, by itself, not a proper rationale to combine or modify references.

Applicants note that in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) (hereinafter, “the *KSR* case”) and cases after the *KSR* case, the Court requires some motivation or reason for one skilled in the art to (i) combine elements of the prior art or (ii) modify a known compound in the way that a new invention does in order to render the new invention obvious. See, for example, the Court decision in *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, No. 2006-1329 (Fed. Cir. 2007) (hereinafter, “the *Takeda* case”), wherein the Federal Circuit stated:

While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the Court acknowledged the importance of identifying “**a reason that would have prompted a person of**

ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. *KSR*, 127 S. Ct. at 1731 (*emphasis added*). Moreover, the Court indicated that there is “no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis.” *Id.* As long as the test is not applied as a “rigid and mandatory” formula, that test can provide “helpful insight” to an obviousness inquiry. *Id.* Thus, in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound.

Although the holding in the *Takeda* case involved motivation for modifying a known compound, Applicants respectfully submit that a similar analysis applies to the required motivation for selecting and combining possible components from a myriad of potential choices. As discussed above and consistent with the holdings in the *KSR* case and the *Takeda* case, the art fails to provide any reason that would have lead one skilled in the art to combine Hopkinson and Schlatter to arrive at the present claims. Applicants respectfully submit that the Examiner failed to identify a rationale that would have prompted a person of ordinary skill in the art to modify the prior art elements in the manner claimed.

For the reasons set forth above, Applicants respectfully submit that the present response overcomes all outstanding objections and rejections. Applicants respectfully request allowance of all claims.

The Commissioner is hereby authorized to charge any additional fees under 37 CFR §1.17 which may be required, or credit any overpayment, to Account No. 50-1676 in the name of Syngenta Crop Protection, Inc.

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Date: May 9, 2012